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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRED REED, ROBERT P. HENNESSEE,
DAVID M. ZEDAN, and ANDREW GILLEN

Appeal 2009-002517
Application 10/767,583
Technology Center 2600

Decided:[1] July 14, 2009

Before JOHN C. MARTIN, KARL D. EASTHOM, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from the Examiner's final rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM-IN-PART.

A. Appellants' invention

Appellants' invention relates to a human-machine interface device for controlling a plurality of vehicle functions. The interface comprises a knob that is axially movable between a first, rest level and a second, pressed level. The knob is bidirectionally rotatable in the rest level to select a vehicle function and bidirectionally rotatable in the pressed level to control the selected vehicle function. Abstract.

B. The claims

Independent claim 1 is reproduced as illustrative:[2]

1. A human-machine interface device for controlling a plurality of vehicle functions, the interface comprising:

a knob which is bidirectionally rotatable at a rest level and a pressed level;

a selected one of said vehicle functions being selected by said knob at said rest level;

said selected one of said vehicle functions being controlled by said knob at said pressed level; and

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[2] Although Appellants nominally argue independent claims 1 and 7 separately from claim 13 (App. Br. 4-6), the arguments presented for these claims are substantially the same. Accordingly, we treat claims 1-3, 7-9, and 13 as a single claim grouping, and select claim 1 as representative of this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

a plurality of annunciators, wherein one of said annunciators indicates said selected one of said vehicle functions when said knob is rotated at said rest level.

C. The references and rejections

The Examiner relies on the following prior art references to show unpatentability:

Hengst	US 6,005,299	Dec. 21, 1999
Ishiguro	US 6,176,589 B1	Jan. 23, 2001
Goldenberg	US 6,636,197 B1	Oct. 21, 2003
Bollgohn	US 6,769,320 B1	Aug. 3, 2004

Claims 1-3, 5, 7-9, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as obvious over Hengst in view of Ishiguro.

Claims 4 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Hengst in view of Ishiguro and Bollgohn.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as obvious over Hengst in view of Ishiguro and Goldenberg.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details.[3] In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

[3] We refer to (1) the Appeal Brief filed Nov. 7, 2007; (2) the Examiner's Answer mailed Dec. 26, 2007; and (3) the Reply Brief filed Feb. 19, 2008, throughout this opinion.

ARGUMENTS AND ISSUES

I. The Examiner found that Hengst discloses all but one of the limitations of claim 1. Ans. 3-4. More specifically, The Examiner found that Hengst discloses, among other limitations, "a knob (1) which is bidirectionally rotatable (8, 9) at a rest level (central position or 10) and a pressed level." Ans. 3. The Examiner also found that "Hengst fails to disclose a plurality of annunciators wherein one of the annunciators indicates the selected one of the vehicle functions when the knob is rotated at the [rest] level." Ans. 4. The Examiner further found though that Ishiguro teaches this missing limitation and that motivation existed to modify Hengst's invention to include this feature. Ans. 4-5.

Appellants initially acknowledged in their Appeal Brief that "Hengst teaches a bidirectional rotary switch 1 (Fig. 2) operable in a pushed position 5 and a pulled position 7." App. Br. 4. Appellants reiterated this position: "Hengst teaches selecting and controlling a function by operating a bidirectional rotary switch 1 (Fig. 2) in a pushed position 5 and a pulled position 7." App. Br. 6. But Appellants subsequently change their position in the Reply Brief, arguing:

> Upon further review of the Hengst reference, Applicants respectfully note that neither Hengst nor the other cited art, alone or in combination, teaches "a knob which [is] bidirectionally rotatable at a rest level and a pressed level" (claim 1), or "a knob which is bidirectionally rotatable at a first level and a second level" (claim 7), or "controlling said one of said functions by rotating said knob at said second level" (claim 13) (emphasis added).
>
> Hengst, while teaching selection by rotation, teaches only activation by pushing or pulling on the knob. Hence, there is no teaching in Hengst of truly controlling the function in the

> pressed or second level by rotation of the knob. The functions in Hengst are merely turned on or off or the levels of menus are changed by pushing or pulling the knob. Note particularly, column 3, lines 28-30 of Hengst:
>
> > ". . . then the rotary function of the rotary switch is inhibited during the pushing motion and the pulling motion of the rotary switch."
>
> The Examiner's characterization of the movement from display screen to display screen as shown in [Fig.] 3 of Hengst is believed to be incorrect. Hengst teaches rotation of the knob only at the central position 3, not the pushed position 5 or the pulled position 7.

Reply Br. 4.

These argument were not necessitated by a new point in the Answer. By failing to raise these arguments in the Appeal Brief, Appellants have waived them. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) ("[A]n issue not raised by an appellant in its opening brief . . . is waived." (citation omitted) (internal quotation marks omitted)); *accord Ex Parte Scholl*, No. 2007-3653 at 18-19 (BPAI Mar. 13, 2008) (Informative), *available at* http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf. For the purposes of the present appeal then, Appellants and the Examiner are deemed to be in agreement that Hengst's knob is bidirectionally rotatable at both the rest level and the pressed level.

The first issue before us, then, is: Have Appellants shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests modifying Hengst's bidirectional rotary knob so as to further include a plurality of annunciators, wherein one of said annunciators

indicates the selected one of the vehicle functions when the knob is rotated at the rest level?

II. Dependent claims 5 and 11 additionally require that the "[bidirectionally rotatable] knob further comprises a switch for controlling said on/off function and said switch includes an indicator reflective of the state of said on/off function." The Examiner cites Ishiguro, Figures 2-5, and column 5, line 50, to column 6, line 8, to support the finding that Ishiguro teaches a knob (35) that performs the claimed ON and OFF functions. Ans. 7. Appellants assert that (1) Hengst makes no mention of any on/off functions or any switches for controlling on/off functions; and (2) "Ishiguro's on/off switches 35 are provided separate and apart from [Ishiguru's] knob dial 18 and are not mounted on the dial knob 18." App. Br. 5.

The second issue before us, then, is: Have Appellants shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests modifying Hengst's bidirectional rotary knob so as to further comprise a switch for controlling an on/off function, wherein the switch includes an indicator reflective of the state of the on/off function?

FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence:

1. "[Ishiguro's] invention relates to a dial operation device having a structure for informing an operator of a rotational position of a knob dial

when a plurality of display sections provided in the knob dial are selectively illuminated." Ishiguro, col. 1, ll. 6-9.

2. Figures 2 and 5 of Ishiguro depict bidirectionally rotatable dial knobs 18, 36 and push-button ON/OFF knobs 35. Ishiguro, Figs. 2 and 5; col. 4, ll. 1-28; col. 5, l. 50–col. 6, l. 11.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974). If the Examiner's burden is met, the burden then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

I.

Appellants and the Examiner agree that Hengst's knob is bidirectionally rotatable at both the rest level and the pressed level. *See*

supra ARGUMENTS AND ISSUES section. Appellants also acknowledge that "Ishiguro teaches a rotary knob dial 18 and annunciators 15a-15e." App. Br. 4. As such, the combination of Hengst and Ishiguro teach every element of claim 1. The only question remaining then is whether motivation exists to incorporate Ishiguro's annunciators onto Hengst's knob.

The Examiner asserts that "[i]t would have been obvious to have modified Hengst with the teaching of Ishiguro [relating to the annunciators 15a-15e], so as to provide a feedback to a user to indicate the rotational position of a knob (see [Ishiguro's] abstract)." Ans. 4. On appeal, Appellants must show error in the Examiner's prima facie determination. *See Oetiker*, 977 F.2d at 1445.

In rebuttal, Appellants only argue that: (1) neither Hengst nor Ishiguro individually teaches all of the elements of claim 1 (App. Br. 4); and (2) "neither Hengst nor Ishiguro includes a suggestion or motivation to combine the bidirectional rotary switch 1 that is operable in pushed and pulled positions and the annunciators 15a-15e" (Ans. 5). Appellants' first argument is not persuasive, as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Appellants' second argument, that no motivation exists to combine the references' teachings, is also not persuasive. As noted above, the Examiner did provide a motivation to combine the references, and Ishiguro does in fact set forth this motivation. FF 1. Furthermore, Appellants have not provided any rationale for why the Examiner's proffered motivation is incorrect.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative claim 1. Accordingly, we will sustain the Examiner's rejection of that claim and also claims 2, 3, 7-9, and 13 which fall with claim 1.

With respect to the obviousness rejections of claims 4, 6, 10, and 12, Appellants provide no patentability arguments directed to the additional references of Bollgohn for claims 4 and 10 or to Goldenberg for claims 6 and 12. Rather, Appellants repeat arguments directed to claims 1 and 7 and apply them to the remaining rejections. App. Br. 6, 7. Accordingly, for the reasons discussed above, we also sustain the obviousness rejections of claims 4, 6, 10, and 12.

II.

We now turn to the second issue of whether Appellants have shown that the Examiner erred in finding the cited prior art collectively teaches or suggests modifying Hengst's bidirectional rotary knob so as to further comprise a switch for controlling an on/off function, wherein the switch includes an indicator reflective of the state of the on/off function. To answer this question, we first look to see whether Ishiguro's ON/OFF knobs 35 are bidirectionally rotatable. We find that they are not.

Figures 2 and 5 of Ishiguro depict bidirectionally rotatable dial knobs 18, 36, as well as push-button ON/OFF knobs 35. FF 2. The Examiner has not pointed to any portion of Ishiguro that would indicate that the push-button knobs 35 are bidirectionally rotatable. Rather, the rectangular and contiguous positioning of the ON/OFF knobs 35 quite clearly depicts that they are not rotatable. We therefore agree with Appellants that Ishiguro

does not teach or suggest including ON/OFF switches onto Hengst's rotatable knobs. *See* App. Br. 5. At most, Ishiguro teaches adding further push-button ON/OFF switches that are separate and apart from rotatable knobs.

For the foregoing reasons, Appellants have persuaded us of error in the Examiner's obviousness rejection of claims 5 and 11. Accordingly, we will not sustain the Examiner's rejection of these claims.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests modifying Hengst's bidirectional rotary knob so as to further include a plurality of annunciators, wherein one of said annunciators indicates the selected one of the vehicle functions when the knob is rotated at the rest level. Accordingly, Appellants have not shown that the Examiner erred in rejecting claims 1-4, 6-10, 12, and 13 under § 103.

Appellants have shown though, that the Examiner erred in finding the cited prior art collectively teaches or suggests modifying Hengst's bidirectional rotary knob so as to further comprise a switch for controlling an on/off function, wherein the switch includes an indicator reflective of the state of the on/off function. Accordingly, Appellants have shown that the Examiner erred in rejecting claims 5 and 11 under § 103.

DECISION

We sustain the Examiner's rejections with respect to claims 1-4, 6-10, 12, and 13. Therefore, the Examiner's decision rejecting claims 1-4, 6-10, 12, and 13 is affirmed.

We do not sustain the Examiner's rejection with respect to claims 5 and 11. Therefore, the Examiner's decision rejecting claims 5 and 11 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

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